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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
087781,579	01/09/97	GARDINER	B GONR9003HEE/

QM31/0330

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EXAMINER	
PHAM, T	
ART UNIT	PAPER NUMBER
3731	<i>B</i>

DATE MAILED: 03/30/98

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action SummaryApplication No.
08/781,579

Applicant(s)

Gardiner et al.

Examiner

Tina Pham

Group Art Unit

3731☒ Responsive to communication(s) filed on Aug 20, 1997☐ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim☒ Claim(s) 1-16, 18, 19, 21-23, and 26-66 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.☐ Claim(s) _____ is/are rejected.☐ Claim(s) _____ is/are objected to.☒ Claims 1-16, 18, 19, 21-23, and 26-66 are subject to restriction or election requirement.**Application Papers**☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on _____ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been received.☐ received in Application No. (Series Code/Serial Number) _____☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☐ Notice of References Cited, PTO-892☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16, 18-19, 21-23, 26-31, drawn to a surgical staple system, classified in class 606, subclass 139.
- II. Claims 32-35, drawn to a needle manipulating system, classified in class 606, subclass 222.
- III. Claims 56-66, drawn to a method of fastening together tissue, classified in class 128, subclass 898 .

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions.

Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the method as claimed can be practiced by another fastening device.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species 1 - Figures 1A-1D.

Species 2 - Figures 2F-2H.

With respect to the instrument used to apply the fastener:

Species A - controls comprises hand-actuated controls.

Species B - controls comprises automated robotic controls.

Species C - controls comprises motor.

Species D - controls comprises pneumatic means.

Species E - controls comprises hydraulic means

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Conclusion


Any inquiry concerning this communication or earlier communications should be directed to Tina D. Pham at telephone number (703) 308-0824. The examiner can normally be reached Monday through Friday from 7:30 AM to 4:00 PM.

If an inordinate number of attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Michael Buiz can be reached at (703) 308-0871. The fax number for the Art Unit is (703) 308-0758.

Any inquiry of a general nature or relating to the status of the application should be directed to the Group receptionist at (703) 308-0858.

Tina T. D. Pham

March 26, 1998


Michael Powell Buiz
Supervisory Patent Examiner
GAU 3309
3/26/98